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27045	7590	06/25/2010	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			COPPOLA, JACOB C	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			06/25/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kara.coffman@ericsson.com

jennifer.hardin@ericsson.com

melissa.rhea@ericsson.com

### Office Action Summary

**Application No.**

10/524,423

**Applicant(s)**

NASLUND ET AL.

**Examiner**

JACOB C. COPPOLA

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-63 is/are pending in the application.
- 4a) Of the above claim(s) 58, 59 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-57 and 60-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office action is in reply to Applicants' claim amendments and remarks filed 30 March 2009 ("09 Mar Response"), and to Applicants' claim amendments and remarks filed on 17 March 2010 ("2010 Mar Response").
2. Claims 54-63 are currently pending.
3. Claims 54-57 and 60-62 have been examined.
4. Claims 58, 59, and 63 have been withdrawn, as noted below.
5. This Office Action is given Paper No. 20100609. This Paper No. is for reference purposes only.

### ***Restrictions***

6. Because Applicants have cancelled the claims corresponding to Groups I and III, namely claims 46-53 and 64-67, the Restriction between Groups I, II, and III (part of Paper No. 20090707) is hereby withdrawn.
7. The Election of Species (also part of Paper No. 20090707) is maintained.
8. Applicants' election without traverse of claims 54-57 and 60-62 in the 2010 Mar Response is acknowledged.
9. Claims 58, 59, and 63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the 2010 Mar Response.

***Specification***

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP §608.01(o), and MPEP §2181 and its discussion of C.F.R. §1.75. Correction of the following is required:

a. The “means for performing a security operation to cryptographically link said usage information with a particular user account or identity” of claim 54.

11. The Examiner notes that the USPTO’s Board of Patent Appeals and Interferences (“Board”) has recently recognized that the lack of antecedent basis of claim terms in the original specification as a “significant problem.” See 73 Fed. Reg. 32944 (June 10, 2008) (noting that “[o]ne significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification.”).

12. Additionally, the Examiner notes that patent examiners have no authority to waive the provisions of a rule. See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b).

13. Because the lack of antecedent basis is currently recognized by the USPTO as a significant problem and because the Examiner has no authority to waive the provisions of a rule, correction of the noted objections to the specification under 37 C.F.R. § 1.75(d)(1) is required.

***Claim Rejections - 35 USC §112, Second Paragraph***

14. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 54-57 and 60-62 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

**Regarding Claims 54-57 and 60-62**

16. Claim element “means for performing a security operation to cryptographically link said usage information with a particular user account or identity” is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph.

17. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

18. Additionally, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

19. Applicants are required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

20. Additionally Applicants are required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If Applicants are of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, Applicants are required to clarify the record by amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)).

***Claim Rejections - 35 USC §103***

21. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 54-57 and 60-62, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Gruse et al. (U.S. 6,389,538 B1) (“Gruse”).

**Regarding Claim 54**

23. Gruse discloses:

receiving agent (Browser and integrated Helper Application of the End User Device **109**) for receiving certain digital content (“content”) from said content provider (“content provider”) (fig. 1D);

rendering device (Player Application **195** of the End User Device **109**) for rendering said received digital content (fig. 1D; see also c. 86, ll. 1+ for overview of Player App.);

logging agent (Copy/Play Management Components **1504**) for monitoring usage information concerning the actual rendering of said digital content by said rendering agent (c. 88, ll. 40+); and

means for performing a security operation to cryptographically link information with a particular user account or identity (see description of means for creating containers and Digital Signatures in at least c. 16, ll. 1+).

24. Gruse does not directly disclose means for performing a security operation to cryptographically link said usage information with a particular user account or identity.

25. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the means for performing a security operation (*i.e.*, the components that create a digital signature), as disclosed by Gruse, to cryptographically link the usage information of Gruse with a particular user identity. One would have been motivated to do so because such link would provide the receiving facility of Gruse with assurance of the integrity of the usage information (see Gruse, at least c. 27, ll. 20-23).

Regarding Claims 55-57 and 60-62

26. Gruse discloses the limitations of claim 54, as shown above, and further discloses the limitations of:

Claim 55: The client system according to claim 54, further comprising means for decrypting said digital content prior to the rendering of said digital content (c. 89, ll. 36+);

Claim 56: The client system according to claim 54, wherein said security operation performing means is configured for performing at least part of an authentication of said usage information (component that creates digital signature performs at least part of the authentication process, see c. 26, ll. 20-2 and c. 16, ll. 1+);

Claim 57: The client system according to claim 54, wherein said usage information comprises a representation of said client-rendered digital content and rendering quality information (c. 88, l. 40 – c. 89, l. 35);



Claim 60: The client system according to claim 54, wherein said logging agent further comprises means for forwarding said logged usage information to an external trusted party for storage therein as a log entry in a log (c. 88, l. 40 – c. 89, l. 35);

Claim 61: The client system according to claim 54, further comprising: a first digital rights management (DRM) agent (decryption **1505** of fig. 15B), at least partly implemented in said rendering device, having functionality for enabling rendering of said digital content;

Claim 62: The client system according to claim 61, further comprising: a second DRM agent (Secure Container Processor **192**) implemented in said client system, having functionality for enabling reception of said digital content from said content provider; and means for communication (Inter-application Communication Components **1508**) between said first DRM agent and said second DRM agent, said first DRM agent comprising means for transferring a first control signal associated with said information to said second DRM agent and said second DRM agent comprises means for processing signal data associated with said first control signal to generate a second control signal, and means for sending said second control signal to said first DRM agent for controlling the digital-content usage process (see at least c. 83, ll. 36-50; c. 89, ll. 52-61; and c. 86, ll. 1-40).

### ***Claim Interpretation***

27. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

28. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases "to," "for," "adapted to," or other functional language (e.g. claim 54 recites "a receiving agent for receiving...") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all claims currently pending.

29. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.<sup>1</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

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<sup>1</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

*associate* “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

*concerning* “In reference to.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;

*enable* “1 a : to provide with the means or opportunity... b : to make possible, practical or easy.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

*for* “1 a – used as a function word to indicate purpose.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986;

*monitoring* “3. To keep track of systematically with a view to collecting information.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000; and

*to* “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

### ***Response to Arguments***

30. The Examiner notes that Applicants have not argued against the application of Gruse’s disclosure in the rejection of dependent claims 55-57 and 60-62. Under 37 C.F.R. §1.111(b) Applicants are required to specifically point out the supposed errors in the previous Office action (mailed on 30 October 2008). Applicants’ silence regarding the merits of the rejection over

Gruse's disclosure with respect to claims 55-57 and 60-62 is taken as an admission that the rejection of these claims is not a supposed error.

31. With respect to claim 54, Applicants argue that "the combination of Gruse, Futamura, and Archibald fails to teach, disclose, or suggest 'performing a security operation to cryptographically link said logged usage information with a particular user account or identity', as recite by independent claims 46 and 54." See 09 Mar Response at p. 8.

32. In response to Applicants' argument that the references fail to show certain features of Applicants' invention, it is noted that the features upon which Applicants rely (*i.e.*, "said logged usage information") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

33. Applicants' remaining arguments have been considered but are moot in view of the new grounds of rejection, the cancellation of claim 67, and the withdrawal of claim 63.

### ***Conclusion***

34. Applicants' amendment filed in the 09 Mar Response necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

35. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

b. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112, first paragraph.

c. Independent of the requirements under 35 U.S.C. § 112, first paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP §608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP §608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is

allowed. See 35 U.S.C. §132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

38. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure (see attached form PTO-892). All references listed on form PTO-892 are cited in their entirety.

39. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/  
Patent Examiner, Art Unit 3621  
June 9, 2010

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621